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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,483	11/10/2005	Yusuke Suzuki	S1459.70092US00	3894
23628 7590 08/03/2010 WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206				
EXAMINER				
HENRY, CALEB E				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,483

Applicant(s)

SUZUKI ET AL.

Examiner

CALEB HENRY

Art Unit

2894

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 8 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-8, and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendments filed on 06/24/2010 have been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugnaux (20040131934).

Regarding claim 1, Sugnaux teaches an electrode for incorporation in a solar cell ((Sugnaux, par. 4)), the electrode comprising a mixture of carbon (Sugnaux, par. 52-55) carrying a metal and a binder (Sugnaux, par. 52-55), **wherein the carbon carrying a metal is prepared prior to mixing with the binder**, the carbon having a specific surface area equal to or larger than 100 m²/g (Sugnaux, par. 50).

Sugnaux does not explicitly teach that the metal is either a pure metal or an alloy metal comprising at least one metal selected from the group consisting of Pt, Ru, Co, Ti, Ni, Al and Au.

However, Sigmaux does teach that the electrode is composed of an activator which includes, but is not limited to Group IIIA elements (Sugnaux, par. 55).

One with common knowledge in the art would know that Group IIIA elements includes, but is not limited to, Al.

The examiner does not give patentable weight in regards to the claim limitation stating that "...**wherein the carbon carrying a metal is prepared prior to mixing with the binder...**" since such a limitation is taken to be a product-by-process limitation and is considered nonlimiting. A product by process claim is directed to the product per se, no matter how actually made. See *In re Fessman*, 180 USPQ 324, 326 (CCPA 1974); *In re Marosi et al*, 218 USPQ 289, 292 (Fed. Cir. 1983); and particularly *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), all of which make it clear that it is the patentability of the final structure of the product "gleaned" from the process steps, which must be determined in a "product by process" claim, and not the patentability of the process. See also MPEP 2113. Moreover, an old or obvious product produced by a new method is not a patentable product, whether claimed in "product by process" claims or not.

Regarding claim 2, Sugnaux teaches an electrode according to claim 1, which is formed on an electrically conductive substrate (Sugnaux, fig. 2, 26).

Regarding claim 3, Sugnaux teaches an electrode according to claim 2 wherein the electrically conductive substrate is made of glass, a polymer film or a metal (Sugnaux, par. 46).

Regarding claim 4, Sugnaux teaches an electrode according to claim 1 wherein the carbon is needle-like carbon, fullerene, carbon nanotube or electrically conductive carbon black (Sugnaux, par. 52-53)

Regarding claim 7, Sugnaux teaches an electrode according to claim 1 wherein the specific surface area of the carbon is equal to or larger than $300 \text{ m}^2/\text{g}$ (Sugnaux, par. 50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugnaux.

In regard to Claim 8 Sugnaux differs from the claimed invention by not showing the amount of the metal carried by the carbon is equal to or more than 5 weight percent of the carbon. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the amount of the metal carried by the carbon is equal to or more than 5 weight percent of the carbon, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 18, Sugnaux teaches an electrode for incorporation in a solar cell (Sugnaux, par. 4), the electrode comprising a mixture of carbon (Sugnaux, par. 52-53) carrying both a metal and a binder (Sugnaux, par. 52-53).

Sugnaux does not explicitly teach that the metal is either a pure metal or an alloy metal comprising at least one metal selected from the group consisting of Pt, Ru, Co, Ti, Ni, Al and Au.

However, Sigmaux does teach that the electrode is composed of an activator which includes, but is not limited to Group IIIA elements (Sugnaux, par. 55).

One with common knowledge in the art would know that Group IIIA elements includes, but is not limited to, Al.

Thus, it would have been obvious to one of ordinary skill in the art at the time said invention was made to use Al, since Sugnaux implicitly teaches this fact.

In regard to Claim 18 Sugnaux differs from the claimed invention by not showing an amount of metal in the electrode ranging between 5 wt % and 15 wt % relative to the carbon. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the an amount of metal in the electrode ranging between 5 wt % and 15 wt % relative to the carbon, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In regard to Claim 19 Sugnaux differs from the claimed invention by not showing the binder in the electrode comprises more than 5 wt % of the carbon. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the binder in the electrode comprises more than 5 wt % of the carbon, since it has been held that where the general conditions of a claim are disclosed in the prior art,

discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugnaux as applied to claim 1 above, and further in view of Ishibashi (JP 2003021410).

Regarding claim 16, Sugnaux teaches an electrode comprising a carbon carrying a metal and a binder.

However, Sugnaux does not teach the electrode is disposed immediately adjacent to an electrolytic layer.

Ishibashi teaches an electrode (fig. 1, page 14, 4) disposed immediately adjacent to an electrolytic layer (fig. 1, page 14, 5).

One with ordinary skill in the art would know that the electrolytic layer acting as an electrochemical contact. Also, both teachings are related to the same field of endeavor i.e. fabrication of solar cells.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Ishibashi to the teachings of Sugnaux due to aforementioned reasons.

Regarding claim 20, Sugnaux/Ishibashi teaches an electrolytic layer (Ishibashi, fig. 1, page 14, 5) disposed adjacent to the electrode (Ishibashi, fig. 1, page 14, 4) and a

semiconductor layer (Ishibashi, fig. 1, page 14, 2) disposed adjacent to the electrolytic layer.

In regard to Claim 20 Sugnaux/Ishibashi differs from the claimed invention by not showing the electrolytic layer having a thickness of between about 1 micron and 100 microns. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the electrolytic layer having a thickness of between about 1 micron and 100 microns, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sugnaux as applied to claim 1 above, and further in view of Yamakawa (US 66566633 B2).

Regarding claim 17, Sugnaux teaches an electrode comprising a carbon carrying a metal and a binder.

However, Sugnaux does not teach the binder is insoluble to electrolytes.

Yamakawa teaches the binder is insoluble to electrolytes (Yamakawa, col. 7, lines 62-67).

One with common knowledge in the art would know by having a binder with such properties, this prevents the diffusion of electrolytes, from the electrolytic layer.

Thus it **would** have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Yamakawa to the teachings of Sugnaux due to aforementioned reasons.

Response to Arguments

Applicant's arguments filed 06/24/2010 have been fully considered but they are not persuasive. Sugnaux teaches that an active component in the electrode can consist of Group IIIA elements, among others (Sugnaux, par. 55). Group IIIA elements include Al which is one of the metals Claim 1 teaches can be used in the electrode composition.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CALEB HENRY whose telephone number is (571)270-5370. The examiner can normally be reached on 9 a.m.-5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Nguyen can be reached on 571-272-2402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CALEB HENRY/
Examiner, Art Unit 2894

/THANH V. PHAM/
Primary Examiner, Art Unit 2894